

## **REMARKS/ARGUMENTS**

### **Drawings**

The documents submitted by the Examining Attorney show no objection to the drawings.

### **Section 112 Rejections**

The Examiner has rejected claims 3 and 11 under 35 U.S.C. 112, as being indefinite for failing to particularly point out and claim the subject matter which applicant regards as the invention.

As to claim 11, it has been cancelled and the rejection is therefore moot.

As to claim 3, it has been amended to instead refer to "the one or more clients", for which there is antecedent basis.

Applicant therefore submits that the Section 112 rejections have been removed.

### **Claim Amendments**

Applicant has added new claims 13-16, which do not add new matter but instead which claim the claim language deleted from the claim upon which they depend.

## **Obviousness - Section 103(a) Rejection**

Preliminarily, the Applicant affirms to the Examiner that the claims and subject matter thereof were commonly owned at the time any inventions covered therein were made.

The Examiner has rejected claims 1-12 under 35 U.S.C. 103(a) as being unpatentable over Jones '353, in view of the "realtor.com" reference and the Sutcliffe '216 reference. Applicant respectfully requests that the Examiner reconsider the rejection because there is nothing in any of the three references which teach, disclose or suggest the desirability of the combination and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness.

First of all, the Examiner has misconstrued the Jones '353 reference, particularly in asserting that the affiliates input photographs and a data set into a template. In Jones, the cited references (col. 3, lines 12-22; and col. 21, lines 37) make it clear that the service bureau publishes the tours which conform to their format. There is not an affiliate entry of data into the template, but instead it is transmitted to the service bureau (by mail or electronically) for the service bureau to then input into the template and create it themselves. This invention on the other hand would allow the user/affiliates to directly input the photographs and data set into the template instead of transmitting the data for the service bureau to input and create the virtual tour. Figure 5 of Jones '353 shows that the raw data 112 must be sent to an engineer for entry into the

database 63, whereas in the applicant's claims, the data is input directly into the template and system without the need for the engineer.

The realtor.com reference does not provide the initial entry template for the affiliate to input the photographs or data set directly.

There is no teaching in either Jones or the realtor.com reference, or suggestion to combine with Sutcliffe '216, and none has been referenced by the Examiner.

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO “failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some

teaching, suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Monteffore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The arguments submitted above apply to independent claims 1, 6, 8 and 9, and the claims which depend upon them are likewise patentable over the art for the same reasons and arguments.

### **Prior Art Made of Record and Not Relied Upon**


The Applicant notes the prior art made of record but not relied upon and asserts that for the reasons set forth above, the claims are allowable over the art made of record.

### **Conclusion**

Applicant therefore submits Claims 1-10 and 13-16 are in a position to proceed to allowance.

Respectfully submitted,

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